

Application No. 10/668,876
Office action dated January 30, 2007
Response dated April 19, 2007

REMARKS

After entry of this amendment, claims 1-17 and 19-32 will be pending. Claims 1-14 stand withdrawn from consideration. Claim 18 has been canceled without prejudice or disclaimer, and the subject matter thereof has been incorporated into claim 15. Claims 15-17 and 19-30 stand rejected.

Claim 15 has been amended, and claims 31 and 32 have been added. Support for the amendments and new claims can be found, *inter alia*, at paragraph [00149] of the specification. No new matter is added by way of the amendment or new claims.

Applicant submits the amendments place the application in condition for allowance, or, in the alternative, in better condition for appeal, and respectfully requests entry of this amendment.

Applicant has thoroughly reviewed the Office action, including the Examiner's remarks and the references cited therein. Applicant submits that the following remarks are fully responsive to the Office action, and that all pending claims are patentable over the cited references.

Rejection Under 35 U.S.C. § 102

The Examiner rejects claims 15, 17-23, 25-27, 28, and 30 under 35 U.S.C. § 102(b) as anticipated by United States patent no. 6,216,045 to Black et al. ("Black"). To be anticipatory, a single prior art reference must explicitly or inherently teach each and every element of the claimed invention. MPEP § 2131 (citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987)). The rejection is moot as to canceled claim 18. As to the remaining claims, Applicant respectfully submits that Black fails to meet this standard.

As amended, claim 15 recites "at least one arbitrarily-shaped electrode overmolded by a portion of the catheter, at least a portion of the at least one arbitrarily-shaped electrode being exposed through the overmold of the catheter and a *portion of the overmold of the catheter remaining adjacent the exposed portion of the at least one arbitrarily-shaped electrode*" (emphasis added). Several advantages of having "a portion of the overmold of the catheter remaining adjacent the exposed portion of the at

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least one arbitrarily-shaped electrode" are discussed at paragraph [00149] of the specification. For example, the overmolding will insulate the electrodes from one another and from adjacent, non-corresponding traces. In addition, the overmold provides support to both the electrodes and the conductive elements, reducing the possibility of damage or breakage. Further, the overmold provides a generally smooth finish to the catheter tip, reducing the possibility of damaging tissue.

The Examiner asserts that Black teaches "at least one arbitrarily-shaped electrode overmolded by a portion of the catheter[.]" Black does not, however, teach "a portion of the overmold of the catheter remaining adjacent the exposed portion of the at least one arbitrarily-shaped electrode[.]" Black teaches electrodes 18 that are recessed relative to and separated by electrode spacers 28. Black, col. 7, lines 5-11 and Fig. 5. Thus, when in the intermediate state relied upon by the Examiner, Black's electrodes are *completely covered* by the overmold of the catheter (e.g., there is no "exposed portion of the at least one arbitrarily-shaped electrode" for the overmold to be adjacent to). It is equally clear that, after the overmold material has been removed by grinding, no overmold remains adjacent the electrode, as the overmold material is removed along with other excess material in order to expose the electrodes that were recessed relative to the spacers, thereby forming an isodiametric lead. *Id.*, col. 7, lines 25-33. Further, because Black's electrodes are recessed relative to the spacers, at no point during the grinding process does Black teach the claimed "at least a portion of the at least one arbitrarily-shaped electrode being exposed through the overmold of the catheter and a portion of the overmold of the catheter remaining adjacent the exposed portion of the at least one arbitrarily-shaped electrode[.]"

Thus, Applicant submits that Black fails to teach each and every element of, and therefore cannot anticipate, claim 15. Claims 17, 19-23, 25-27, 29, and 30 depend, directly or indirectly, from claim 15, and are allowable for at least the same reasons. Applicant therefore respectfully requests reconsideration and withdrawal of the rejection under section 102(b).

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Rejections Under 35 U.S.C. § 103

The Examiner rejects claims 16 and 28 under 35 U.S.C. § 103 as obvious over Black. The Examiner also rejects claim 24 under 35 U.S.C. § 103 as obvious over Black in view of United States patent no. 5,125,913 to Quackenbush ("Quackenbush"). To establish a *prima facie* case of obviousness, the Examiner must demonstrate some suggestion or motivation to combine one or more references, with a reasonable expectation of success, to teach or suggest each and every claimed limitation. MPEP § 2142. Applicant contends that the Examiner has failed to meet this burden with respect to the rejected claims as amended herein. Specifically, the asserted references do not teach or suggest each and every element of the claimed invention, and in fact teach away from the claimed invention.

Motivation to combine references may only be found in the teachings of the prior art, the nature of the problem to be solved, and the knowledge of persons of ordinary skill in the art. MPEP § 2143.01(I) (citing *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998)). Further, it is not sufficient that the asserted references can be combined; the prior art must suggest the desirability of the combination. MPEP § 2143.01(III) (citing *In re Mills*, 910 F.2d 680 (Fed. Cir. 1990)). The burden of establishing that the combination is desirable rests squarely upon the Examiner. *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

The shortcomings of Black with respect to amended claim 15 have been discussed at length above. To reiterate, Black explicitly teaches removing all excess materials, including overmold materials, to expose the electrode structure. Indeed, Black discloses removal of even a portion of the electrode itself in order to achieve a unitized, substantially isodiametric lead. Black, col. 2, lines 28-46 and col. 7, lines 26-29.

Applicant also respectfully points out that Black teaches that overmolding places the electrode spacers 28 and the terminal spacers 30 in a state of flow, at least in part resulting "in a filling of regions between terminals 16/electrodes 18 and stylet guide 24. Consequently, terminals 16 and electrodes 18 are partially surrounded (i.e., along an interior surface) and supported by a fused matrix of material." Black, col. 7, lines 12-19. As a result, there is no reason, justification, or motivation to leave any overmold material

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behind after the grinding process disclosed in Black, especially since the electrodes are recessed relative to the spacers and all excess materials are removed to form an isodiametric lead.

Nor are the shortcomings of Black addressed through the addition of Quackenbush. Thus, not only does Black fail to teach or suggest the desirability of the claimed invention, Black actually teaches away from the claimed invention. Applicant therefore respectfully submits that one of ordinary skill in the art would not be motivated to modify Black as suggested by the Examiner without the improper application of hindsight in light of the present invention. See In re Kotzab, 217 F.3d 1385, 1371 (Fed. Cir. 2000) ("Particular findings must be made as to the reason the skilled artisan, *with no knowledge of the claimed invention*, would have selected these components for combination in the manner claimed.") (emphasis added); Teleflex, Inc. v. KSR Int'l, 119 Fed. Appx. 282, 285 (Fed. Cir. 2005); see also MPEP § 2145(X).

Accordingly, claims 16, 28, and 24, which depend, directly or indirectly, from claim 15, are allowable for at least the same reasons that claim 15 is allowable. The rejections under 35 U.S.C. § 103 should be reconsidered and withdrawn.

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CONCLUSION

In view of the foregoing remarks, Applicant respectfully submits that the application is in condition for allowance, and requests that all rejections be withdrawn, that all pending claims be allowed, and that the application be passed to issue. If, for any reason, the Examiner finds the application to be in other than condition for allowance, the Examiner is invited to contact the undersigned in an effort to resolve any matter still outstanding before issuing another action.

No extension of time is believed necessary for this paper to be considered timely. Should an extension of time be deemed necessary, Applicant hereby petitions therefor under 37 C.F.R. § 1.136.


Authorization is hereby granted to charge any fees due with the filing of this document, including any fees for any extensions of time deemed necessary, to Deposit Account No. 50-1129 with reference to Attorney Docket No. 08-045000US/82410-0067.

Respectfully submitted,

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